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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

23952-0145

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on 6-23-06Signature Mal U. GriffinTyped or printed name Malvern U. Griffin

Application Number

09/867,589

Filed

May 31, 2001

First Named Inventor

Hogan

Art Unit

3624

Examiner

Havan, Thu Thao

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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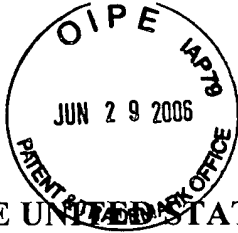
☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 38,889☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____Mal U. Griffin
SignatureMalvern U. Griffin, Esq.
Typed or printed name404-853-8233
Telephone number6-23-06
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 09/867,589
Filed : May 31, 2001
Applicant : Hogan
Title : Electronic Bill and Non-bill Information Presentation

TC/AU : 3624
Examiner : Havan, Thu Thao

Docket No. : 23952-0145
Customer No. : 29052

PRE-APPEAL BRIEF REVIEW STATEMENT

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This statement describes the bases for which review is being requested pursuant to the Notice of Appeal and the Pre-Appeal Brief Request for Review submitted concurrently herewith in connection with the above-identified application.

The Rejections

Claims 1-30 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 6,289,322 to Kitchen et al. (hereinafter "Kitchen"). In the Final Office Action it is stated that Kitchen teaches non-bill information as personal information. More specifically, the Examiner argues that FIG. 11 of Kitchen discloses a page with a payer's personal information such as his name and address that is presented to the payor in an electronic billing notice. However, no *prima facie* case of anticipation has been properly established because, as detailed below, the Examiner has failed to show that Kitchen teaches the transmission of "a location identifier of non-bill information upon which the charge is based."

The Invention

Applicants' claims are directed to a method for presenting a bill and associated non-bill information via a network. A bill including a charge and a location identifier of non-bill information upon which the charge is based is transmitted to a payer. Upon receiving a request for the non-bill information from the payer, the non-bill information is transmitted to the payer via the network. For example, in one illustrative embodiment, an electronic bill for an insurance premium may be transmitted to a payer. The bill may include one or more location identifiers that link to portions of the insurance contract upon which the present charges are based. If the user selects one of the location identifiers, such as the location identifier associated with a charge for collision coverage, the portion of the insurance contract pertaining to the payer's collision coverage will be transmitted to the payer. Please see, for example, Paragraph 0052 and FIG. 4A of the Application.

I. The Examiner Clearly Errs by Failing to Show That Kitchen Teaches the Transmission of "a location identifier of non-bill information upon which the charge is based" as Recited in Independent Claims 1, 9, 18, 23, 29, and 30.

The Examiner expressly relies on Kitchen to meet Applicants' claim limitations recited in independent Claims 1, 9, 18, 23, 29 and 30 of "a location identifier of non-bill information upon which the charge is based." The Examiner argues that Kitchen discloses non-bill information in an electronic billing notice because personal information such as the name and address of a biller or payer are transmitted with a billing notice (see Final Office Action, Response to Arguments, page 3). The Examiner, however, makes no argument as to how

Kitchen discloses the transmission of a location identifier of non-bill information upon which a charge is based, as required by each of the independent claims of the present invention.

In the Response to the Non-final Office Action, the Applicants argued that the Examiner had cited no part of Kitchen which teaches the element of a location identifier for non-bill information (see Response to Office Action, page 3). The Examiner failed to address this argument in the Final Office Action. Instead, the Examiner simply pointed to FIG. 11 of Kitchen to argue that the transmission of personal information such as a name and address on an electronic billing notice constitutes the transmission of non-bill information. FIG. 11 of Kitchen depicts detailed bill presentment information that may be sent to a user upon request (col. 15, lines 55-65). The detailed bill presentment screen of FIG. 11 does contain what the Examiner has termed personal information related to the payer; however, the displayed personal information does not constitute a location identifier of non-bill information upon which a charge is based. Contrarily, the so-called personal information is plain text that does not reference the location of additional information. Additionally, what the Examiner has termed personal information, such as a payer's name and address, does not constitute non-bill information because such information typically appears on a bill.

The Examiner also argued in the Non-final Office Action that the act of a payer logging on to the Internet to access a bill pay system in Kitchen is the equivalent of the present invention. However, this is clearly not the case. Kitchen does disclose the transmission of a notice of availability of a bill to a payor (col. 7, lines 5-16); however, Kitchen does not disclose the transmission of a location identifier with the notice of availability. Even if a location identifier that accessed the login screen of Kitchen were disclosed, it would have been

transmitted to the user as part of a notice of availability of a bill rather than as part of a bill, as required by the claims of the present invention. Furthermore, any location identifier that may be transmitted as part of a notice of availability would only reference the login process and not non-bill information upon which a charge is based.

Accordingly, the Examiner has failed to point to any portion of Kitchen that teaches or suggests the transmission of “a location identifier of non-bill information upon which a charge is based.” The Examiner, therefore, has clearly erred by failing to demonstrate that Kitchen anticipates each element of the independent claims of the present invention.

II. The Examiner Clearly Errs in His Assertion that Kitchen Teaches that “the first non-bill information is a first portion of a document; and the second non-bill information is a second portion of the same document”

Independent Claims 1 and 9 of the present invention claim both a location identifier of first non-bill information and a location identifier of second non-bill information. Dependent Claims 2 and 10 further claim that the first non-bill information is a first portion of a document and the second non-bill information is a second portion of the same document. Accordingly, multiple location identifiers may be used to reference the same document or even to index a particular document.

The Examiner argues that the personal information disclosed by Kitchen contains multiple items of personal information within the same screen and, therefore, anticipates Claims 2 and 10 of the present invention. However, by failing to show that Kitchen uses location identifiers, the Examiner has failed to show that a first location identifier references a first

portion of a document and that a second location identifier references a second portion of the same document. Accordingly, the Examiner, has clearly erred by failing to demonstrate that Kitchen anticipates Claims 2 and 10 of the present invention.

Conclusion

No *prima facie* case of anticipation has been established for Applicants' claims 1-30. The Examiner has failed to show that the Kitchen patent discloses all of the elements and limitations of Applicants' claims. Accordingly, prompt allowance of each claim is respectfully solicited.

Respectfully submitted,



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Date: **June 23, 2006**
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